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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT PAPER NUMBER

2154

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/734,975

Applicant(s)

MORAN, THOMAS

Examiner

Ashok B. Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-31 are subject to examination. Claims 20—31 are new claims.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claim 1-3, 10-12 and 15-17 have been considered but are moot in view of the new ground(s) of rejection.

However, Examiner would like to thank the Applicant for providing the clarification on the claims limitations by stating "Applicant has therefore amended the term "associated with said user" to replace it by the term "specific to said user" (emphasis added) at all occurrences throughout the claims as currently pending in this application. This amendment clarifies that the pre-specified message that is stored at the messaging server and that is to be sent from the messaging server to a destination party mail box in response to a user input is a message that is specific to that user and, by inference, not specific to other users. The pre-specified message is made specific to the user by virtue of the fact that the user creates the message for storage on the messaging server by way of pre-recording the message at the user's mail box. Basis for this amendment is found at page 2, lines 19 to 21."

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

Art Unit: 2154

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Lung et al. (hereinafter Lung)(US 6, 532, 230 B1).

**Referring to claim 1,**

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box (Fig. 4), said messaging system comprising a communications network comprising:-

a) a messaging server arranged to store a pre-specified message specific to said user (Fig. 4, element 535, col. 7, line 32-36, "Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive a user input from said user; and

c) a destination party mail box; wherein when a specified user input is received from said user at the input, the pre-specified message is sent to the destination party mail box from the messaging server. (col. 7, line 36-44, " In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (a directory or file), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area

Art Unit: 2154

associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630.”)

**Referring to claim 2,**

Lung teaches a messaging system as claimed in claim 1 wherein said input comprises a terminal connected to the communications network and comprising a user interface.

(Fig. 4, element “DESKTOP COMPUTER”, col. 6, line 30-32)

**Referring to claim 3,**

Lung teaches a messaging system as claimed in claim 2 wherein the terminal is connected to the messaging server via a communications network node being a private branch exchange. (Fig. 2, element “CO”, col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38).

**Referring to claim 4,**

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user of the pre-specified message. (Fig. 4, element 440, col. 7, line 1-12)

**Referring to claim 5,**

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user to the pre-specified message to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message. (col. 7, line 32-44, Figs. 9 and 10)

**Referring to claim 6,**

Art Unit: 2154

Lung teaches a messaging system as claimed in claim 5 wherein the processor is arranged to create the combined message such that, in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message. (col. 7, line 32-44, Figs. 9 and 10)

**Referring to claim 7,**

Lung teaches a messaging system as claimed in claim 1, wherein the messaging server is a multimedia messaging server.(Fig.4, element 535)

**Referring to claim 8,**

Lung teaches a messaging system as claimed in claim 1 wherein the destination party mail box is located on a second messaging server. (Fig.11)

**Referring to claim 9,**

Lung teaches a messaging system as claimed in claim 3 wherein the communications network node is arranged to route the additional information to the messaging server together with one or more control signals that are arranged to indicate that the additional information is to be appended to a pre-specified message. (col. 8, line 53-62)

**Referring to claim 10,**

Lung teaches a messaging system as claimed in claim 1 wherein the pre-specified message is stored in a mail box on the messaging server, said mail box being associated with the user. (Fig.11)

**Referring to claim 11,**

Lung teaches a method of sending a pre-specified message specific to a user, from said user to a destination party mail box in a communications network (Fig. 4), said method comprising the steps of:-

- (i) storing said pre-specified message at a messaging server in the communications network (Fig.4, element 535, col. 7, line 32-36);
- (ii) receiving an input from said user, said input indicating that the pre-specified message is to be sent to the destination party mail box ; and
- (iii) sending the pre-specified message from the messaging server to the destination party mail box. (col. 7, line 36-44)

**Referring to claim 12,**

Lung teaches a method as claimed in claim 11 wherein the input is received via a terminal. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

**Referring to claim 13,**

Lung teaches a method as claimed in claim 12 which further comprises setting up a call between the terminal and the messaging server and receiving information from the user via this call, to be appended to the pre-specified message.(col. 9, line 49-52)

**Referring to claim 14,**

Lung teaches a method as claimed in claim 13 wherein the call is routed via a communications network node between the terminal and the messaging server and wherein that communications network node is arranged to send a control signal to the messaging server, indicating that the received information is to be appended to the pre-

specified message. (col. 9, line 49-52, Fig. 4, Fig.11, (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38)

**Referring to claims 15,**

Lung teaches a messaging server for sending a pre-specified message specific to a user, from said user to a destination party mail box in a communications network (Fig. 4, element 408, and Fig. 11), said messaging server comprising:

- (i) a store containing the pre-specified message (Fig. 4, element 510);
- (ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (Fig.4, elements 535 and 520, col. 7, line 36-44);
- (iii) a processor arranged to send the pre-specified message to the destination party mail box (Fig.4, element 440).

**Referring to claim 16,**

Lung teaches a communications network comprising a destination party mail box and a messaging server for sending a pre-specified message specific to a user, from said user to the destination party mail box (Figs. 4 and 11), said messaging server (Fig.4, element 408) comprising:

- (i) a store containing the pre-specified message specific to said user (Fig. 4, element 510);
- (ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (col. 7, line 36-44); and



(iii) a processor arranged to send the pre-specified message to the destination party mail box. (Fig.4, element 440).

**Referring to claim 17,**

Claim 17 is a claim to a computer program that carries out the method steps of claim 15. Therefore, claim 17 is rejected for the reasons set forth for the claim 15.

**Referring to claim 18,**

Lung teaches a communications signal arranged to be routed between a terminal and a messaging server, said communications signal comprising information associated with a user and a control signal which indicates that the information is to be appended to a pre-specified message at the messaging server, said pre-specified message being specific to said user.(Fig.5)

**Referring to claim 19,**

Lung teaches a communications network node arranged to be connected between a terminal and a messaging server, said communications network node comprising a processor arranged to set up a call between the terminal and the messaging server and to route information specific to a user from the terminal to the messaging server using this call, wherein the processor is further arranged to send a control signal with the routed information, said control signal indicating that the routed information is to be appended to a pre- specified message at the message server, said pre-specified message being associated with said user. (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38, col. 7, line 32-44).

**Referring to claim 20,**

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box(Fig. 4),, said messaging system comprising a communications network comprising:

a) a messaging server arranged to store a pre-specified message(Fig. 4, element 535, col. 7, line 32-36, "Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive a user input from said user; and

c) a destination party mail box; wherein when a specified user input is received from said user at the input, the pre-specified message is sent to the destination party mail box from the messaging server (col. 7, line 36-44," In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (a directory or file), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630.");

wherein the messaging system further comprises a processor arranged to append spoken information received from the user to the pre-specified message prior to

Art Unit: 2154

it being sent to the destination party mail box. (Fig.5, col. 10, line 49-52," An e-mail message may also be text alone, text and an image, an image alone, a presentation with images, text and audio narration or accompaniment, or any other data converted for transmittal via an electronic mail system."

**Referring to claim 21,**

Lung teaches a messaging system as claimed in claim 20 wherein said input comprises a user terminal connected to the communications network and comprising a user interface. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

**Referring to claim 22,**

Lung teaches a messaging system as claimed in claim 21 wherein, in response to a further user input, said processor is arranged to establish a call between the user terminal and the messaging system to receive from said user the spoken information to be appended to the pre-specified message. (col. 9, line 49-52)

**Referring to claim 23,**

Lung teaches a messaging system as claimed in claim 20 wherein the processor is arranged to append the spoken information received from the user to the pre-specified message to create a combined message such that the messaging server is later able to separate the appended spoken information from the combined message. (col. 9, line 49-52, col. 7, line 32-44, Figs. 9 and 10)

**Referring to claim 24,**

Lung teaches a messaging system as claimed in claim 20 wherein the pre-specified

message is stored in a mail box on the messaging server, said mail box being associated with the user. (Fig.11)

**Referring to claim 25,**

Claim 25 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 20. Therefore claim 25 is rejected for the reasons set forth for claim 20.

**Referring to claim 26,**

Claim 26 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 21. Therefore claim 26 is rejected for the reasons set forth for claim 21.

**Referring to claim 27,**

Claim 27 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 22. Therefore claim 27 is rejected for the reasons set forth for claim 22.

**Referring to claim 28,**

Claim 28 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 23. Therefore claim 28 is rejected for the reasons set forth for claim 23.

**Referring to claim 29,**

Claim 29 is a claim to a messaging server that carries out the method of claim 25. Therefore claim 29 is rejected for the reasons set forth for claim 25.

**Referring to claim 30,**

Art Unit: 2154

Claim 30 is a claim to communications network incorporating the system of claim 20.

Therefore claim 30 is rejected for the reasons set forth for claim 20.

**Referring to claim 31,**

Claim 31 is a claim to computer program stored on a computer readable medium, said computer program being for controlling a messaging server of claim 29. Therefore claim 31 is rejected for the reasons set forth for claim 29.

***Conclusion***

**Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 2154

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp  
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